

be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

At no point in Hayashi et al. is any mention ever made of the transporter carriage holding two discs. In contrast, Hayashi et al.'s transporter carriage is specifically designed for one disk. The transporter carriage 8 does have disc holding pallets 9, but the limitation of "holding the first and a second compact disc simultaneously, such that the first and second compact discs are held in fixed relative positions" is not met by the structure of Hayashi et al. In fact, the pallets, when they rotate to change the position of the discs they carry, actually drop the discs, which are transferred to the opposite pallet for the purposes of inverting the disc. See for example, column 6, line 65 to column 7, line 2. Since the combination of Balsom and Hayashi et al. does not teach each limitation of claim 1, Applicant respectfully submits that claim 1 is allowable. Claim 4 depends from and further defines patentably distinct claim 1 and is also believed allowable.

Claim 9 recites "first and second gripping locations each for respectively holding the first and second compact discs simultaneously, such that the first and second compact discs maintain a fixed axial position while engaged by the gripping head." Applicant respectfully submits that this limitation is neither taught nor suggested by Balsom in combination with Hayashi et al., as discussed further above. As such, Applicant submits that claim 9 is allowable. Claim 13 depends from and further defines patentably distinct claim 9 and is also believed allowable.

Claims 14-17 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Balsom (U. S. Patent No. 5,592,596) in view of Hayashi et al. (U.S. Patent No. 6,304,525). Applicant strongly traverses this rejection.

Claim 14 recites in the preamble that the method is for operating a disc processing system that includes "a transporter carriage for simultaneously holding at least two compact discs in a fixed axial relation." As has been discussed above with respect to

claims 1 and 9, neither Balsom nor Hayashi et al., nor a combination thereof, teach or suggest that recitation of claim 14. Applicant respectfully submits that claim 14 is allowable. Claims 15-17 depend from and further define patentably distinct claim 14 and are also believed allowable.

Claims 18, 19, and 21-26 were rejected for the same reasons as claim 1, with the assertion by the Office Action that because they are drawn to methods for using the apparatus of claim 1, they are also rejected. There has been no actual showing of where in the cited art the exact limitations of the method claims are present. Applicant submits that this rejection is improper, since the Office Action has not set out with sufficient detail any allegations that would allow Applicant to even see what the actual rejection is. It is not sufficient to allege that the apparatus is rejected, and therefore the methods are also rejected.

Further, Applicant submits that the apparatus is patentable over the cited references, and that certain operations of the apparatus, which have been discussed above in the context of the apparatus claims, are not shown in the combination of Balsom and Hayashi et al. Specifically, claim 18 recites that "the first and second compact discs are held in fixed axial positions coextensive along a common axis in different planes while the first and second compact discs are engaged by the gripping head." Claims 19 and 22-25 each recite in the preamble that the method is performed on "a transporter carriage for simultaneously holding at least two compact discs on first and second planes such that the two discs are held in fixed relative positions coextensive along a common axis in different planes." Claim 21 recites that "the first and second compact discs are held in fixed axial positions while the first and second compact discs are engaged by the gripping head." Claim 23 further recites that "the first compact disc and a second compact disc are held in fixed relative positions by the gripper head." This limitation is not taught by Balsom, by Hayashi et al., or by any suggestion or teaching in any combination thereof, and Applicant respectfully submits that claims 18, 19, and 21-26 are allowable. Claim 26 depends from and further defines patentably distinct claim 25 and is also believed allowable.

Claims 27 and 30 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Balsom (U. S. Patent No. 5,592,596) in view of Hayashi et al. (U.S. Patent No. 6,304,525). Applicant strongly traverses this rejection.

Claim 27 recites that "the first and second compact discs maintain a fixed axial relation while engaged by the gripping head" and claim 30 recites that "the first and second compact discs are held in fixed axial positions while the first and second compact discs are engaged by the gripping head." This limitation is not taught by Balsom, by Hayashi et al., or by any suggestion or teaching in any combination thereof, and Applicant respectfully submits that claims 27 and 30 are allowable.

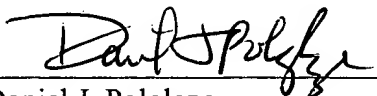
CONCLUSION

In view of the above remarks, Applicant respectfully submits that the claims are in condition for allowance and requests reconsideration of the application and allowance of claims.

The Examiner is invited to contact Applicant's Representatives at direct dial (612) 312-2203 if there are any questions regarding this Response or if prosecution of this application may be assisted thereby.

Respectfully submitted,

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